

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Yamamoto et al.	Art Unit :	1628
Patent No. :	7,994,159	Examiner :	Anna Pagonakis
Issue Date :	August 9, 2011	Conf. No. :	3373
Serial No. :	10/797,903		
Filed :	March 10, 2004		
Title :	C-KIT KINASE INHIBITORS		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentees hereby request reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to adjust total PTA from 1,222 days to 1,188 days is respectfully requested.

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. Patentees respectfully submit that the Office did not apply the proper standard for determining the period of “B Delay” under 35 U.S.C. § 154(b)(1)(B).

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

Applicant Delay

Patentees filed a Supplemental Reply on September 27, 2007, subsequent to a reply filed on August 15, 2007. Patentees were accorded a delay of 43 days for a supplemental response. Patentees do not dispute the PTO’s calculation for this Applicant Delay from August 16, 2007, to September 27, 2007. See 37 C.F.R. § 1.704(c)(8).

A reply to an Office Action was due on or before March 11, 2008 (the date that is three months after December 11, 2007, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on April 4, 2008, thereby according an Applicant Delay of 24 days. Patentees do not dispute the PTO’s calculation for this Applicant Delay from March 12, 2008 (the day after the date that is three months after the date on which the Office Action was mailed), to April 4, 2008. See 37 C.F.R. § 1.704(b).

CERTIFICATE OF MAILING BY EFS-WEB FILING

I hereby certify that this paper was filed with the Patent and Trademark Office using the EFS-WEB system on this date: October 7, 2011.

A reply to an Office Action was due on or before October 23, 2008 (the date that is three months after July 23, 2008, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on January 23, 2009, thereby according an Applicant Delay of 92 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from October 24, 2008 (the day after the date that is three months after the date on which the Office Action was mailed), to January 23, 2009. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before November 20, 2009 (the date that is three months after August 20, 2009, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on January 20, 2010, thereby according an Applicant Delay of 61 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from November 21, 2009 (the day after the date that is three months after the date on which the Office Action was mailed), to January 20, 2010. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before December 1, 2010 (the date that is three months after September 1, 2010, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on December 29, 2010, thereby according an Applicant Delay of 28 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from December 2, 2010 (the day after the date that is three months after the date on which the Office Action was mailed), to December 29, 2010. See 37 C.F.R. § 1.704(b).

Patentees filed an Information Disclosure Statement on January 10, 2011, subsequent to a reply filed on December 29, 2010. Patentees were accorded a delay of 12 days for a supplemental response. Patentees do not dispute the PTO's calculation for this Applicant Delay from December 30, 2010, to January 10, 2011. See 37 C.F.R. § 1.704(c)(8).

Patentees filed an Information Disclosure Statement on March 9, 2011, subsequent to a reply filed on January 10, 2011. Patentees were accorded 0 days delay for a supplemental response. In good faith and candor, Patentees submit that the supplemental response should have been accorded a total Applicant Delay of 58 days for delay from January 11, 2011, to March 9, 2011. See 37 C.F.R. § 1.704(c)(8).

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 318 days (i.e., the sum of 43 days, 24 days, 92 days, 61 days, 28 days, 12 days, and 58 days).

“A Delay”

A first PTO action was due on or before May 10, 2005 (the date that is fourteen months after March 10, 2004, the date on which the application was filed). The PTO mailed the first non-final Office Action on July 17, 2007, thereby according a PTO Delay of 798 days. Patentees do not dispute the PTO's calculation for this “A Delay” from May 11, 2005 (the day after the date that is fourteen months after the date on which the application was filed), to July 17, 2007. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

In view of the period of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 798 days.

“B Delay”

There is no dispute that the Office failed to issue a patent within three years of the filing date of the application and that Patentees are entitled to “B Delay” to compensate for that Office delay. The only issue in contention is the correct length of the “B Delay” period.

The period beginning on March 11, 2007 (the day after the date that is three years after the date on which the application was filed), and ending August 9, 2011 (the date the patent was issued), is 1,613 days in length. The “PTA 36 Months” entry in the PAIR/PALM system indicates that a total of 684 days were awarded for “B Delay” for this patent. Patentees respectfully submit that the PTO's calculation of this “B Delay” is incorrect.

Section 154(b)(1)(B)(i) of Title 35 excludes from the calculation of “B Delay” “any time consumed by continued examination of the application.” In the present matter, a Request for Continued Examination was filed on June 23, 2009. The Director erred in the calculation of patent term adjustment by subtracting from “B Delay” a period of time that was not “consumed by continued examination of the application.” The PTO mailed a Notice of Allowance on March 10, 2011, thereby closing examination of the application on that date. Thus, no continued examination took place during the 153 day period from March 10, 2011 (the mailing date of the

Notice of Allowance), until August 9, 2011 (the date the patent was issued). Accordingly, 153 days of "B Delay" should have been included in addition to the 684 days accorded by the Director, for a total "B Delay" of 837 days. Patentees respectfully submit that the Office's calculation of "B Delay" is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 837 days.

Overlap of "A Delay" and "B Delay"

As detailed above, 798 days of "A Delay" accumulated during the following period:

May 11, 2005, to July 17, 2007.

As detailed above, 837 days of "B Delay" accumulated during the following periods:

March 11, 2007, to January 23, 2009; and

March 11, 2011, to August 9, 2011.

As such, the periods of "A Delay" and "B Delay" overlap (i.e., occur on the same calendar day) for a total of 129 days, from March 11, 2007, to July 17, 2007.

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Conclusion

In consideration of the events described above, Patentees believe the PTA calculation of 1,222 days is incorrect. As such, Patentees respectfully request reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 1,506 days (i.e., the sum of 798 days of "A Delay" and 837 days of "B Delay" minus 129 days overlapping delay);
- 2) Total Applicant Delay should be calculated as 318 days; and
- 3) Total PTA should be calculated as 1,188 days.

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Page : 5 of 5

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The \$200 fee required under 37 C.F.R. § 1.18(e) is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other credits or charges to Deposit Account No. 06-1050, referencing Attorney Docket No. 25142-0002001.

Respectfully submitted,

Date: October 7, 2011

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